

REMARKS*Status of the Claims*

Claims 14-33 were in the application as examined.

Claims 14 stands objected to because certain alleged informalities relating to

(i) not including the language comprising “the steps of”; and

(ii) a lack of clarity with respect to the identity of a particular “message”

where an antecedent basis is presented as “at least one locator message.”

Claim 14 stands rejected on the ground of obviousness-type double patenting over U.S. Patent No. 6,732,145 B1.

Claims 14 and 17-33 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 5,862,330 to Anupam (hereinafter “Anupam ‘330”).

Claims 15 and 16 stand rejected under 35 U.S.C. § 103(a) as obvious over Anupam ‘330.

References cited, but not applied in rejecting claims, are said by Examiner as being pertinent to applicant’s disclosure. More specifically, it is said that U.S. Patent 5,649,185 to Antognini (hereinafter “Antognini”) contains limitations that are said to be relevant to applicant’s claims 15-16 regarding server and clients that are co-located or resident in the same computer. Reference is made by Examiner to Antognini’s col. 4, line 64 to col. 5, line 3.

Amendments to the claims

Claim 14 is amended by this response.

Response to Double-Patenting Rejection of Claim 14

By present submission, a terminal disclaimer is filed to overcome or avoid this basis for rejection.

Response to Objections to Claim 14

Applicant’s attorney respectfully differs with Examiner’s view that the present method claim 14 is deficient for failing to include the language “the steps of.” While such usage is commonly employed by claim drafters, no statutory or regulatory reason appears to require that language; none has been cited by Examiner.

This rejection would appear to require that all system or apparatus claims (*e.g.*, directed to “machines” or “manufactures” in the sense of 35 USC §101) must, in an analogous manner, include the language “the elements of” (or other generic term). Requirements to amend claims should not be required merely to suite a particular drafting style, especially when such amendments provide no meaningful additional clarity.

However, to avoid unnecessarily protracting prosecution of this application, applicant has included the language “the steps of” in claim 14.

The preamble of Claim 14 has also been presently amended to more clearly provide the exact antecedent basis for later recitations of “said at least first and second clients.” Previously claim 14 had recited “A method for facilitating collaborative viewing by a plurality of collaborators....” As amended claim 14 recites “[a] method for facilitating collaborative viewing by at least first and second collaborators” This does not change the meaning of claim 14, but may avoid any possible confusion regarding the identity of the “locator message(s)” cited by Examiner.

In regard to the objection of the identity of the “locator message(s)”, then, it should be noted that the preamble of claim 1 (as presently amended) recites

facilitating collaborative viewing by at least first and second collaborators at respective clients ... of at least one resource..., the method practiced at a collaboration server...,

the collaboration server performs

receiving from at least one of said clients at least one resource selection message ... identifying said at least one resource....

Upon receiving at least one resource selection message - there may be one or more than one resource selection message - the collaboration server then performs

responding to said at least one resource selection message by generating at least one locator message addressed to said at least first and second clients, each of said locator messages comprising at least one locator associated with said at least one resource....

Thus, the collaboration server generates at least one locator message in response to (at least one received resource selection message). Since there may be more than one locator message generated, claim 14 provides that

each of said locator messages comprising at least one locator associated with said at least one resource.... [Emphasis added.]

It appears that Examiner may be interpreting “at least one locator message” as “exactly one locator message.” Applicant has expressly used the language “at least one” in various parts of the claims to specify that there may be one of something (*e.g.*, message), or there may be more than one of something (*e.g.*, messages). So, if the identity of the “message” to which Examiner has raised an issue of clarity, then applicant’s response is that since “at least one locator message” is present, it is “each of said locator messages.” In the special case where there is exactly one locator message generated by the collaboration server, the “message” sought by Examiner is that one locator message; if the collaboration server responds with more than one locator message, then each of them is a message meeting the terms of the claim.

Applicant submits that claim 14 does not suffer from a lack of clarity as suggested by Examiner. Accordingly, the bases for objection to claim 14 are overcome or avoided.

Arguments in Support of Patentability of the Claims

Claims 14 and 17-33 stand rejected under 35 U.S.C. § 102(e) as anticipated by Anupam ‘330. This rejection is respectfully traversed.

Initially, it is noted that the present application is a continuation application based on parent Application No. 09/141,088 (hereinafter, the ‘088 application) filed August 27, 1998. As such the present application has the same description as the parent ‘088 application. The ‘088 application was the subject of a review by the U.S. P.T.O. Board of Patent Appeals and Interferences (hereinafter, “the Board”).

A principal reference cited in the final rejection of the parent ‘088 application was U.S. Patent 5,991,796 to Anupam, *et al.* (hereinafter ‘796). Anupam ‘796 is a continuation of Anupam ‘330 cited in rejecting claims 14 and 17-33 (and claims 15 and 16) in the present application.

The Decision by the Board mailed September 11, 2003 in the appeal in the ‘088 application (copy attached) includes the following findings and conclusions (starting near

the bottom of page 6) with regard to Anupam '796 in reversing an obviousness rejection based on a combination of Anupam '796 with US Patent 5,944,791 to Scherpbier:

* * *

Since Anupam ['796] supplies an actual copy of the URL to all participants except the manager that initiated the session, i.e., what appellants call the “leader,” Anupam ['796] also does not supply the URL to all of the participants, as required by the claim. [Emphasis added.]

One might argue that the claims require an URL to be supplied to a first and second client computer and so any two of the computers in Anupam ['796] can be these claimed “first” and “second” client computers. But, since the instant claims require that the URL be selected through browser software running on the first client computer,” it is clear that since the leader,” or the client computer selecting the URL, in Anupam ['796] does not, itself receive a copy of the message including the URL, i.e., there is no “generating a message addressed to the at least first and second client computers, the message including the URL of the document to be viewed at the at least first and second computers,” Anupam ['796] cannot supply to Scherpbier this teaching or the teaching of an URL selected through the use of browser software running on the first client computer, as claimed. If the “first” client computer in Anupam ['796] is causing the generation of the message, then the message is not addressed to the first computer and, therefore, Anupam ['796] cannot teach such a message addressed to “the at least first and second client computers,” as claimed. [Emphasis Added.]

Anupam '796 has the same disclosure as the presently asserted Anupam '330, and claim 14 (as presently amended) provides

collaborative viewing by at least first and second collaborators at
respective at least first and second clients

* * *

receiving from at least one of said clients at least one resource selection
message comprising information identifying said at least one resource,

* * *

responding to said at least one resource selection message by generating at
least one locator message addressed to said at least first and second clients ..., and

* * *

sending said locator messages to said network for delivery to said at least
first and second clients.

Therefore, with the same factual contexts, and using the same reasoning as the Board in the above-cited appeal, Anupam '330 cannot teach the “sending said locator messages to

said network for delivery to said at least first and second clients” when the generation of the locator messages is made in response to a resource selection message received from at least one of the clients. Anupam ‘330 does not broadcast locator messages to all participants (e.g., providing URLs to “said at least first and second clients”). As in the Board decision, this is the case because Anupam ‘330 does not teach applicants’ claim 14 step of sending locator messages to all clients, including the client from which the resource selection message was received.

For this reason it is submitted claim 14 is distinguishable over Anupam ‘330 (and Anupam ‘796). Likewise, none of the other references cited but not applied provide this teaching. For this reason it is submitted that claim 14 is patentable over Anupam ‘330 and other art of record under 35 U.S.C. § 102(e).

Since claims 17-33 (and 15 and 16 as well) depend from, and include all of the limitations of, claim 14, it is submitted that these claims also are patentable as overcoming or avoiding the provisions of 35 U.S.C. § 102(e) over the art of record.

Rejection of Claims 1 under

35 U.S.C. § 103(a) as obvious over Sriram

The rejection of claims 15 and 16 under 35 U.S.C. § 103(a) as obvious over Anupam ‘330 is respectfully traversed. Since only the “co-location” features are discussed by Examiner with regard to claims 15 and 16, it is necessary that the other features incorporated in claims 15 and 16 from claim 14 are as described in the rejection of claim 14, above.

As noted above, claims 15 and 16 include all of the limitations of claim 14. Accordingly, the above-quoted portions of claim 14 that distinguish over Anupam ‘330 are also found in claims 15 and 16 by reference. The essential features cited by the Board in the ‘088 appeal as absent in Anupam ‘796 (and therefore from Anupam ‘330) are present in applicants’ claims 15 and 16 by reference to claim 14. No teaching or suggestion of these features was found in Anupam, and, to the contrary, the Board found that Anupam specifically teaches away from the “broadcast” features of the present invention as recited in claim 14. Therefore, the “co-location” issues raised by Examiner are moot.

References Cited But Not Applied

Applicant has considered the references cited but not applied to the claims as presently amended, and finds nothing in these references that would adversely affect the allowability of these claims. As noted, the "co-location" feature issues are mooted by the above arguments and the substance of findings and conclusions of the Board in the '088 appeal.

Conclusion

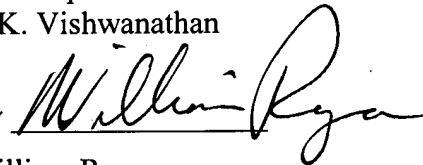
For the foregoing reasons, it is respectfully submitted that claims 14-33 as presently amended overcome or avoid all bases for rejection or objection and are allowable. It is requested that all claims be further examined, found allowable and passed to issue.

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Respectfully,

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By



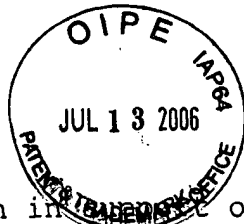
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Date: July 10, 2006

Attach:
Copy of Decision by Board of
Patent Appeals and Interferences
Mailed September 11, 2003
in Appeal No. 2002-0097
Application No. 09/141,088



SHD

The opinion in BOARD OF of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 18

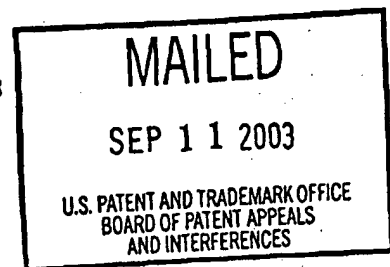
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MURALI ARAVAMUDAN, ANDREAS C. PAPANICOLAOU,
AKA and KUMAR K. VISHWANATHAN

Appeal No. 2002-0097
Application No. 09/141,088

ON BRIEF



Before HAIRSTON, KRASS and FLEMING, Administrative Patent Judges.
KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-5, 7-9 and 11.

The invention is directed to collaborative browsing among users at two or more different personal computers. Copies of selected URLs are shared among collaborating computers, each of which uses the URL to retrieve the corresponding document. A computer is configured to select hyperlinks for itself and one or

Appeal No. 2002-0097
Application No. 09141,088

more other computers. Each URL corresponding to a selected hyperlink is communicated via the Internet to a server. The server broadcasts the URL to the collaborating computers, each of which retrieves the corresponding document in conventional fashion.

Representative independent claim 1 is reproduced as follows:

1. A method of facilitating collaborative browsing of documents containing hypertext by at least two client computers each having access to the Internet, the documents accessible from at least one server computer accessible from the Internet, the method comprising the steps of:

obtaining a URL corresponding to a document which is accessible from a first server, the document to be viewed at at least a first and second client computer, the URL having been selected through use of browser software running on the first client computer;

generating a message addressed to the at least first and second client computers, the message including the URL of the document to be viewed at the at least first and second computers; and

transmitting the message to the at least first and second client computers, the URL included in the message to be used by each of the at least first and second client computers to retrieve and display the document to be viewed.

The examiner relies on the following references:

Scherpbier	5,944,791	Aug. 31, 1999 (filed Oct. 4, 1996)
Anupam et al. (Anupam)	5,991,796	Nov. 23, 1999 (eff. filing date Jul. 16, 1996).

Appeal No. 2002-0097
Application No. 09141,088

Claims 1-5, 7-9 and 11 stand rejected under 35 U.S.C. § 103 as unpatentable over Scherpier in view of Anupam.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teachings, suggestions or implications in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc. ,

Appeal No. 2002-0097
Application No. 09141,088

776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1040, 228 USPQ 685, 687 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 146-147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR 1.192 (a)].

In accordance with appellants' grouping of the claims, at page 2 of the principal brief, all claims will stand or fall together.

Appeal No. 2002-0097
Application No. 09141,088

It is the examiner's position that Scherpbier discloses the claimed subject matter but for the generation of a message to the at least first and second client computers, the message including the URL of the document to be viewed at the at least first and second computers and the transmission of the message to the at least first and second client computers, the URL included in the message to be used by each of the at least first and second client computer to retrieve and display the document to be viewed.

The examiner turns to Anupam for a teaching of a collaborative web browsing system wherein the server transmits the URL of a web page to all participants to be used by the participants to retrieve the web page, citing column 1, line 19 - column 2, line 7 of Anupam.

The examiner concludes therefrom that it would have been obvious to incorporate the method of sending the second computer the URL, as taught by Anupam, into the collaboration system of Scherpbier "in order to provide flexibility of a collaboration system by allowing each participant to 'pull' web pages from servers thereby avoiding a bottleneck at the server computer" (answer-pages 4-5).

Appeal No. 2002-0097
Application No. 09141,088

We will not sustain the rejection of claim 1, or of claims 2-5, 7-9 and 11, under 35 U.S.C. § 103 because we agree with appellants that the examiner's rejection is faulty on at least two counts.

First, the alleged combination is suspect in that since Scherpbier uses a control site to modify a page before it is sent to a second computer and Anupam provides participants, other than the "leader," in a collaborative session with a URL so that all participants can view a particular page, it appears unlikely that the skilled artisan would have sought to modify Scherpbier's limited viewing system with Anupam's universal distribution of the URL so that all may view without modification of the corresponding document.

Second; even if such a combination were to be made by the artisan, it does not appear that the claimed subject matter would result. The collaborator in Scherpbier is not viewing a website corresponding to a URL, but rather a modified version of the corresponding document. Anupam, on the other hand, provides an actual copy of the URL to each participant. Thus, in Scherpbier, an actual URL is not provided to each participant, as required by the instant claims. Since Anupam supplies an actual copy of the URL to all participants except the manager that initiated the

Appeal No. 2002-0097
Application No. 09141,088

session, i.e., what appellants call the "leader," Anupam also does not supply the URL to all of the participants, as required by the claim.


One might argue that the claims require an URL to be supplied to a first and second client computer and so any two of the computers in Anupam can be these claimed "first" and "second" client computers. But, since the instant claims require that the URL be selected through browser software running on the "first client computer," it is clear that since the "leader," or the client computer selecting the URL, in Anupam does not, itself, receive a copy of the message including the URL, i.e., there is no "generating a message addressed to the at least first and second client computers, the message including the URL of the document to be viewed at the at least first and second computers," Anupam cannot supply to Scherpbier this teaching or the teaching of an URL selected through the use of browser software running on the first client computer, as claimed. If the "first" client computer in Anupam is causing the generation of the message, then the message is not addressed to the first computer and, therefore, Anupam cannot teach such a message addressed to "the at least first and second client computers," as claimed.

Appeal No. 2002-0097
Application No. 09141,088

Accordingly, since there appears to be no reason for the artisan to have combined the applied references and, even if so combined, the instant claimed subject matter does not appear to be obtained, we will not sustain the rejection of claims 1-5, 7-9 and 11 under 35 U.S.C. § 103.


The examiner's decision is reversed.

REVERSED


KENNETH W. HAIRSTON
Administrative Patent Judge


ERROL A. KRASS
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES


MICHAEL R. FLEMING
Administrative Patent Judge

EK/RWK

Appeal No. 2002-0097
Application No. 09141,088

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